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09/456,897	12/08/1999	KEITH THOMAS AHERN	PHA-23.778	7056

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EXAMINER

YUAN, ALMARI ROMERO

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/456,897

Applicant(s)

AHERN, KEITH THOMAS

Examiner

Almari Yuan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-26 is/are pending in the application.
- 4a) Of the above claim(s) 27-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment filed on 6/3/03.
2. The rejection of claims 1-15 under 35 U.S.C. 102(b) as being anticipated by Simpson has been withdrawn as necessitated by amendment.
3. Claims 1-15 are cancelled. Claims 16-33 are newly added claims and are pending in this case. Claims 16 and 27 are independent claims.

#### ***Information Disclosure Statement***

4. The information disclosure statement filed on 6/28/01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The foreign search report is not a proper content of Information Disclosure Statement (see MPEP 37 CFR 1.98(a)(2)) and the documents cited as "A" on the foreign search report must be provided for consideration.

#### ***Election/Restrictions***

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 16-26, drawn to a method for producing and rendering an electronic document, classified in class 715, subclass 526.

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II. Claims 27-33, drawn to a method for encoding or converting an electronic document from the parsing of an element of an input document, classified in class 715, subclass 523.

6. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as encoding or converting an electronic document from parsing of an element of an input document to determine if element is a text element or script element to be able to write the determined element to an output file, if element is a script element converting the script element to an invisible sequence.

See MPEP § 806.05(d).

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because the search required for Groups I and II are separate, restriction for examination purposes as indicated is proper.

8. Newly submitted claims 27-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 27-33 are drawn to encoding an electronic document from the parsing of an element of an input document to determine if element is a text element or script element; writing determined elements to an output file; and if element is a script element converting the script element to an invisible sequence.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 16-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freund, Jim ("HotDog Professional 5.1 Webmaster Suite: HotDog 5.1 Cuts the Mustard", 11/1998, Computer Shopper, Vol. 18, No. 11, pages 1-2) in view of Business Wire, "HotDog powers Web authors to new heights", 10/1996, pages 1-2), and in further view of Powers et al. (USPN 6,362,817 B1 – filed on 05/1998).**

**Regarding independent claim 16, Freund discloses:**

A method of producing an electronic document, comprising:

Freund discloses "providing a first text portion, the first text portion exclusive of script" and "wherein the first text portion comprises visible characters", on page 1: teaches HotDog HTML editor offers a main editing window with a preview area that shows how your file will appear in a browser (visible characters). You can choose to have ROVER that takes up the lower

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half of Edit Window and dynamically display the effect your edits have on your document (text portion).

However, Freund does not explicitly teach “providing a first script portion, the first script portion exclusive of text” and “the first script portion consists of invisible characters”.

Business Wire discloses “providing a first script portion, the first script portion exclusive of text” and “the first script portion consists of invisible characters”, on page 1: teaches the HotDog Professional Web editor includes ROVER (Real-time Output ViewER) which is able to preview Java, Java script, style sheets, etc. without starting a browser and wherein a Java Script tool can be used by the users to create professional design effects, in other words, the user can edit Java scripts (includes invisible characters) and preview the output of the Java script without starting the browser.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Business Wire into Freund to provide ROVER (Real-time Output ViewER) which you can preview the Java scripts, as taught by Business Wire, incorporated into the ROVER of Freund, in order to provide users an effective Web editing tool.

However, Freund and Business Wire do not explicitly teach “location parameter identifier” and “location coordinate”.

Powers does disclose “location parameter identifier” and “location coordinate”, on col. 16, lines 30-51: teaches location parameters that specifies the location of the POPUP; the POPUP tag specifies the type of popup (see col. 16, lines 44-51: shows a segment of POPUP tag with POPUP location parameters (1,3,2) and coordinates (COORDS= “(100,100)”).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Powers into Freund and Business Wire to provide a way to specify location parameters and coordinates of a type of element (POPUP), as taught by Powers, incorporated into the script for editing using HotDog HTML editor feature ROVER (Real-time Output ViewER) of Freund and Business Wire, in order to quickly and efficiently operate generation of views on a user's computer system.

**Regarding dependent claims 17 and 18, Freund discloses:**

communicating first text portion (Freund on page 1: teaches ROVER that takes up the lower half of Edit Window and dynamically display the effect your edits have on your document (displaying text portion)) and communication the first script portion (Business Wire on page 1: teaches ROVER (Real-time Output ViewER) which is able to preview Java, Java script, style sheets, etc. without starting a browser and wherein a Java Script tool can be used by the users to create professional design effects (script portion)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Business Wire into Freund to provide ROVER (Real-time Output ViewER) which you can preview the Java scripts, as taught by Business Wire, incorporated into the ROVER of Freund, in order to provide users an effective Web editing tool.

**Regarding dependent claim 19, Freund discloses:**

rendering the electronic document (Freund on page 1: teaches ROVER that takes up the lower half of Edit Window and dynamically display (rendering) the effect your edits have on your document.

**Regarding dependent claims 20, Freund discloses:**

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displaying the first text portion without regard to the first script portion, and without displaying the first script portion (Freund on page 1: teaches main editing window offers a preview area that shows how your file (text portion) will appear in a browser, in other words, a full browser preview can be used instead (displaying text portion without script portion)).

**Regarding dependent claim 21, Freund discloses:**

formatting the first text portion in accordance with the first script portion and without displaying the first script portion (Freund on page 1: teaches ROVER that takes up the lower half of Edit Window and dynamically display the effect your edits have on your document. However, a full browser preview can be used instead (displaying text portion without script portion)).

**Regarding dependent claim 22, Freund discloses:**

replacing at least one of the visible characters of the first text portion (Freund on page 1: teaches text-based HTML editor (replacing) using ROVER that takes up the lower half of Edit Window and dynamically display the effect your edits have on your document (displaying text portion including visible characters)), with one or more visible characters determined by the first script portion (Business Wire on page 1: teaches ROVER (Real-time Output ViewER) which is able to preview Java, Java script, style sheets, etc. without starting a browser and wherein a Java Script tool can be used by the users to create professional design effects (script portion)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Business Wire into Freund to provide ROVER (Real-time Output ViewER) which you can preview the Java scripts, as taught by Business Wire, incorporated into the ROVER of Freund, in order to provide users an effective Web editing tool.



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**Regarding dependent claims 23-25, Power discloses:**

Powers does disclose "location parameter identifier" and "location coordinate", on col. 16, lines 30-51: teaches location parameters that specifies the location of the POPUP; the POPUP tag specifies the type of popup (see col. 16, lines 44-51: shows a segment of POPUP tag with POPUP location parameters (1,3,2) and coordinates (COORDS= "(100,100)"; where the POPUP will be located when displayed).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Powers into Freund and Business Wire to provide a way to specify location parameters and coordinates of a type of element (POPUP), as taught by Powers, incorporated into the script for editing using HotDog HTML editor feature ROVER (Real-time Output ViewER) of Freund and Business Wire, in order to quickly and efficiently operate generation of views on a user's computer system.

**Regarding dependent claim 26, Freund discloses:**

wherein visible characters comprises codes that when processed by a display application result in the display of characters (Freund on page 1: teaches HotDog HTML editor offers a main editing window with a preview area that shows how your file will appear in a browser (visible characters)); and wherein invisible characters comprise codes that when processed by a display application do not result in the display of characters (Business Wire on page 1: teaches the HotDog Professional Web editor includes ROVER (Real-time Output ViewER) which is able to preview Java, Java script, style sheets, etc. without starting a browser and wherein a Java Script tool can be used by the users to create professional design effects, in other words, the user can

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edit Java scripts (includes invisible characters) and preview the output of the Java script without starting the browser).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Business Wire into Freund to provide ROVER (Real-time Output ViewER) which you can preview the Java scripts, as taught by Business Wire, incorporated into the ROVER of Freund, in order to provide users an effective Web editing tool.

### *Response to Arguments*

11. Regarding Applicant's arguments filed on 6/3/03 are moot in view of the new ground(s) of rejection as necessitated by amendment.

Regarding Applicant's remarks on pages 6-7:

Freund discloses "text portion" on page 1: teaches a HotDog HTML editor offers a main editing window with a preview area that shows how your file will appear in a browser (visible characters). You can choose to have ROVER that takes up the lower half of Edit Window and dynamically display the effect your edits have on your document (text portion).

Business Wire discloses "script portion" on page 1: teaches a HotDog Professional Web editor includes ROVER (Real-time Output ViewER) which is able to preview Java, Java script, style sheets, etc. without starting a browser and wherein a Java Script tool can be used by the users to create professional design effects, in other words, the user can edit Java scripts (includes invisible characters) and preview the output of the Java script without starting the browser.

Powers discloses "location parameter identifier" and "location coordinate", on col. 16, lines 30-51: teaches location parameters that specifies the location of the POPUP; the POPUP tag

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specifies the type of popup (see col. 16, lines 44-51: shows a segment of POPUP tag with POPUP location parameters (1,3,2) and coordinates (COORDS= "(100,100)").

### *Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

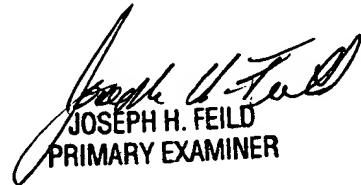
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Yuan whose telephone number is (703) 305-5945. The examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

AY  
August 11, 2003

  
JOSEPH H. FEILD  
PRIMARY EXAMINER